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communicating one of (1) said at least one receiver specific datum and (2) said second sequence of images to one of said plurality placing said at least one receiver specific datum at or clearing said at least one receiver specific datum from a memory in response to said instruct signal.

25. (New) The method of claim 7, wherein said one or more output devices include a television monitor and said interactive image output apparatus receives some of a television program, said method further comprising the steps of:

selecting and passing said some of a television program to the television monitor for delivery to a user;

generating the balance of a series of complete video images for said television program; and

synchronizing the delivery of said generated balance of a series of complete video images at said television monitor based on said schedule.

II. REMARKS

By the foregoing amendment, claims 2, 3, 4, 5 and 7 have been amended. Claims 8-25 have been added. These changes are believed not to introduce new matter. Claims 2-25 remain pending in this application.

A. Introduction

The Office Action dated May 23, 1996 has been carefully reviewed. As to the grouping of paragraphs numbered 2 in the Office Action, applicants acknowledge and

appreciate the interviews provided by the PTO. Applicants also appreciate the detailed description of the interviews provided in the Office Action. In the interest of maintaining a clear record, however, applicants respectfully traverse the Office Action's interview summary statement that an offer was made to terminally disclaim the present application with respect to the '81 or '87 patents. Rather, applicants respectfully submit that their offer was to disclaim a block of co-pending applications against one another, provided their issue date was in close enough proximity so as not to result in unnecessarily great losses in patent term duration.

As to the paragraph numbered 4 in the Office Action, applicants will address the art rejection of this Office Action. Applicants, however, traverse the assertion that a double patenting situation exists. The present application claims priority under 35 U.S.C. § 120 of the following applications:

<u>Serial No.</u>	<u>Filing Date</u>	<u>Patent No.</u>
08/113,329	August 30, 1993	Pending
08/056,501	May 3, 1993	5,335,277
07/849,226	March 10, 1992	5,233,654
07/588,126	September 25, 1990	5,109,414
07/096,096	September 11, 1987	4,965,825

As to the paragraph numbered 5 in the Office Action, applicants acknowledge their duty to maintain a line of patentable demarcation between related applications. Assuming *arguendo* that substantially duplicate claims do exist, applicants intend to make a good faith effort to alert the PTO of any instances in which the PTO treats such claims inconsistently.

As to the paragraph numbered 6 in the Office Action, applicants acknowledge and appreciate the examiner's concern over the use of alternative claim language. Applicants assert that they believe that the disclosure supports every possible embodiment or permutation that can be created using said language. During the prosecution of this application, applicants intend to ensure that the disclosure supports each possible embodiment claimed using alternative claim language.

B. Rejection of Claims 3-7 Under 35 U.S.C. §112 ¶2

In paragraph 7 of the Office Action, the examiner rejected claims 3-7 as being indefinite for failing to particularly point out and distinctly claim the subject matter of applicants' invention. Applicants have amended the claims to more particularly claim their invention. In addition, as explained below, applicants respectfully traverse certain bases of the examiner's rejection. Applicants have therefore either rendered moot or traversed the examiner's rejection. Accordingly, applicants request that the examiner withdraw the rejection of claims 3-7 under 35 USC §112 ¶2.

The examiner stated that the recited function of the received instruct signals of Step (1) of claim 4 does not satisfy the requirements of 35 USC §112 ¶6 in terms of functional relationship. Applicants note that the examiner has failed to cite any case law or MPEP section as the basis for this rejection. Nonetheless, applicants have amended claim 4 to obviate the examiner's concerns.

The examiner also stated that certain terms do not appear in the specification or patent and original claims. Applicants assert that one of ordinary skill in the art would have understood and appreciated the use of the provided terminology.

The examiner finally stated that the phrasing “and a output . . . signal” of claim 4 is unclear, and reference to “the storage device” lacks antecedent basis. Applicants point out that the phrase “and a output . . . signal” does not appear in claim 4 nor claim 7. Similarly, claim 7 does not include the phrase “storage device.” Accordingly, Applicants request that the examiner withdraw this ground of rejection.

C. Rejection of Claim 7 Under 35 U.S.C. §112 ¶1 and ¶2

In paragraph 8 of the Office Action, the examiner rejected claim 7 as failing to describe the invention in such full, clear, concise and exact terms as to enable one skilled in the art to make and use the invention, and for failing to particularly point out and distinctly claim the subject matter of applicants’ invention. Applicants have amended claim 7 to more particularly claim their invention. In addition, as explained below, applicants respectfully traverse certain bases of the examiner’s rejection. Applicants have therefore either rendered moot or traversed the examiner’s rejection. Accordingly, applicants request that the examiner withdraw the rejection of claim 7 under 35 USC §112 ¶1 and ¶2.

D. Objection to the Specification Under 35 U.S.C. §112 ¶1

In paragraph 10 of the Office Action, the examiner objected to the specification as failing to provide an adequate written description of the invention and failing to provide an enabling disclosure for the invention of claim 2. Specifically, the examiner stated that the specification lacks material which correlates to the claimed "value designating a present or projected property interest of a subscriber" and fails to describe how the value is processed in response to an instruct-to-generate signal in order to generate a schedule. Applicants have amended claim 2 to more particularly claim their invention. The term "value" has been cancelled, and replaced with "one or more subscriber data" which is fully enabled in applicants' specification.

Accordingly, applicants assert that the specification provides an adequate written description of the invention as well as an enabling disclosure for the invention of claim 2. Applicants therefore respectfully request that the examiner reconsider and withdraw the objection to the specification under 35 U.S.C. §112 ¶1.

E. Rejection of Claim 2 Under 35 U.S.C. §103

In paragraph 12 of the Office Action, the examiner rejected claim 2 as being unpatentable over Schoeneberger et al. or Campbell et al.. Applicants respectfully traverse this rejection. Schoeneberger et al. discloses a data communication system consisting of a central data processor, remote data processors, and terminal units whereby the remote data processors send commands to the terminals, said commands

related to data acquisition and control functions regarding security devices at the terminals which control access to a cable television network. Campbell discloses an addressable cable television control system which has a converter which receives control data allowing the system operator to control subscription television services on a per channel, per service tier, and per event basis. The system and converter also enable each subscriber to define his own level of required eligibility based on program subject matter. Neither Schoeneberger nor Campbell discloses the concepts of one or more subscriber data designating a subject of interest of a subscriber, or generating a schedule based on said one or more subscriber data. Schoeneberger and Campbell relate to receiving mass medium program material based on control and selection external from the terminal or converter. Also, in Schoeneberger and Campbell, selection is not based on a schedule generated by the receiving devices, as with the present application claim 2. The concepts in claim 2 of the present application are not directly suggested or inferred by Schoeneberger or Campbell taken alone or in combination. Applicants submit that claim 2 of the present application is not obvious from these references. Applicants respectfully request that this rejection be withdrawn.

F. Rejection of Claim 3 Under 35 U.S.C. §103

In paragraph 13 of the Office Action, the examiner rejected claim 3 as being unpatentable over Lambert alone, or further in view of Yarbrough et al., Schoeneberger et al., and Campbell et al. considered collectively. Applicants respectfully traverse this rejection and assert that the claimed invention and the cited references differ more than

just in terminology usage, as suggested in the Office Action. Lambert discloses a system for selective viewing of television programming. In Lambert, a viewer selects a program of interest, from a program schedule broadcast to the public, and then views it shortly thereafter. This programming is also transmitted to other subscribers desiring it. The programming is based on a schedule that was sent to all subscribers. Lambert fails to disclose storing subscriber data at a subscriber station, receiving a viewer's response to a combined medium presentation at the subscriber station, and transferring one or more subscriber specific data from said subscriber station to a remote station based on the viewer's response, as claimed in present claim 3.

Yarbrough discloses an apparatus for automatically monitoring and controlling the recording or receiving of copyrighted or otherwise privileged programs. Coded signals identify the programs and indicate whether they are copyright protected or not. The apparatus stores selected programs based on a comparison between stored selected codes identifying programs and the codes received with the programs. As discussed supra, Schoeneberger discloses a data communication system whereby the remote data processors send commands to the terminals, said commands related to data acquisition and control functions regarding security devices at the terminals which control access to a cable television network. Campbell discloses an addressable cable television control system which has a converter which receives control data allowing the system operator to control subscription television services on a per channel, per service tier, and per event basis. The system and converter also enable each subscriber to define his own level of required eligibility based on program subject matter. Neither Yarbrough,

Schoeneberger, or Campbell directly suggests or infers the concept of transferring one or more subscriber specific data to a remote station based on receiving a viewer's or participant's response to a combined medium output as stated in present application claim 3. All four references relate to the transferring of programming or information to the subscriber. None of the four references suggest transferring specific data to a different remote site based any input received at said subscriber station. The concepts in claim 3 of the present application are not directly suggested or inferred by Lambert, Yarbrough, Schoeneberger, or Campbell taken alone or in combination. It is respectfully submitted that claim 3 of the present application is not obvious from these references. Applicants respectfully ask that this rejection be withdrawn.

G. Rejection of Claims 4-6 Under 35 U.S.C. §103

In paragraph 14 of the Office Action, the examiner rejected claims 4-6 as being unpatentable over Lambert alone, or in view of Campbell et al. or Schoeneberger et al.. Applicants respectfully traverse this rejection. The Office Action relates the term "instruct signal", as defined in the present application claim 4, with program menu number as disclosed in Lambert, "control signal", in claim 4, with means under computer control and "specific time", in claim 4, with standard TV communication equipment times including start-up times. This is an erroneous interpretation of Lambert and the present application claim 4. The Office Action implies that a "means under computer control", where means in Lambert is a video tape cassette, disc, or film

(Lambert Fig. 1 item 25), or some other television program sources (Lambert Fig. 1 item 26), is the same as present application claim 4 step (2) operation. The structure recited in Lambert, and as stated in the Office Action on page 15, is an entirely different concept and does not relate at all to that in the present application claim 4. The term "control signals", as used in the present application claim 4, are signals with information that is generated, can be modified, and can be transmitted. The items referenced in the Office Action are physical structures which are not generated, cannot be modified, and cannot be transmitted. The Office Action's interpretation of the term "control signals" in the present application claim 4, to mean "means under computer control" is in error and misapplies the Lambert reference to the invention claimed in the present application. The Office Action's interpretation that the term "specific time", in claim 4 of the present application, relates to standard TV communication equipment times is also in error. The term "specific time", in claim 4 of the present application, is the time when the control signal is to take effect at the intermediate transmitter station. The control signal controls the intermediate data transmitter station. Any Lambert concept of equipment startup delay applies to the present transmission times to communicate over a network. Schoeneberger discloses a data communication system whereby the remote data processors send commands to the terminals, said commands related to data acquisition and control functions regarding security devices at the terminals which control access to a cable television network. Campbell discloses an addressable cable television control system which has a converter which receives control data allowing the system operator to control subscription television services on a per channel, per service tier, and per

event basis. The system and converter also enable each subscriber to define his own level of required eligibility based on program subject matter. The concepts in claim 4-6 of the present application are not directly suggested or inferred by Lambert, Campbell, or Schoeneberger taken alone or in combination. It is respectfully submitted that claims 4-6 of the present application are not obvious from these references. Applicants respectfully ask that this rejection be withdrawn.

H. Rejection of Claim 7 Under 35 U.S.C. §103

In paragraph 15 of the Office Action, the examiner rejected claim 7 as being unpatentable over Lambert, Yarbrough et al., Schoeneberger et al. and Campbell et al. as applied to claim 3 above, further in view of Brown ("Addressable Control - A Big First Step Toward The Marriage of Computer, Cable, and Consumer," Pioneer Communications of America, Cable 1991). Applicants respectfully traverse this rejection. None of the references cited in the Office Action, Lambert, Yarbrough et al., Schoeneberger et al., or Campbell et al, as discussed previously, directly suggests or infers the concepts in claim 7 of the present application of: (1) generating or assembling, one or more messages which operate at an interactive image output apparatus to generate a schedule and to output a second sequence of images in accordance with said schedule, or (2) delivering said information at said one or more output devices on the basis of said one or more messages. The Office Action misinterprets the claim 7 of the present invention when it states that "[it would be obvious to] generate (assemble) at

the remote site (station) a schedule of programs" Office Action at page 17. Claim 7 of the present application, as amended, relates to assembling of "messages" which operate to generate a schedule, not assembling of programs. The concepts in claim 7 of the present application are not directly suggested or inferred by Lambert, Yarbrough, Schoeneberger, or Campbell taken alone or in combination. It is respectfully submitted that claim 7 of the present application is not obvious from these references, and applicants respectfully ask that this rejection be withdrawn.

I. Rejection of Claims 2-7 Based on MPEP Section 804(II)(B)(2)

As to the Office Action's rejection (in paragraphs collectively numbered 19, 20, and 22) of applicants' claims under a non-statutory non-obvious type of double patenting, applicants strongly traverse the examiner's double patenting rejection on three separate grounds. First, the applied section, MPEP § 804 (II)(B)(2) defining non-statutory non-obvious double patenting, is predicated on an improper reading of case law, and, thus, the resultant rejection constitutes an ultra vires action by the PTO. Second, the PTO's present rejection based on MPEP section 804 (II)(B)(2) is no more than an application of the now discredited late claiming doctrine. Third, even assuming *arguendo* that the non-statutory non-obvious double patenting rejection set forth in MPEP § 804 (II)(B)(2) is a proper reading of case law, and not in violation of the Administrative Procedure Act, this class of rejection does not apply to the factual situation of the present application **which only relies on the September 1987 filing date.** Each contention is addressed separately infra.

1. Non-Statutory Non-Obvious Double Patenting Is Not A Valid Basis For Rejection Because The Commissioner Of The PTO Acted Beyond His Statutory Authority (Ultra Vires).

The PTO, as a government agency, obtains its statutory authority from Congress in Title 35 of the United States Code. Under 35 U.S.C. § 6, the PTO Commissioner has the authority to establish rules and regulations, but only such rules that are not “inconsistent with law. . . .” 35 U.S.C. § 6(a). “[T]he validity of a regulation promulgated thereunder will [only] be sustained so long as it is ‘reasonably related to the purposes of the enabling legislation.’” Mourning v. Family Publications Service, Inc., 411 U.S. 356, 369, 36 L. Ed. 2d 318, 93 S. Ct. 1652 (1973) (quoting Thorpe v. Housing Authority of Durham, 393 U.S. 268, 280, 21 L. Ed. 2d 474, 89 S. Ct. 518 (1969)). An agency is given deference in its interpretation of a statute, but courts “must reject administrative constructions of the statute . . . that are inconsistent with the statutory mandate” Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425 (Fed. Cir. 1988) (quoting FEC v. Democratic Senatorial Campaign Committee, 454 U.S. 27, 32, 70 L. Ed. 2d 23, 102 S. Ct. 38 (1981)). Applicants respectively assert that the PTO’s reliance upon In re Schneller, 397 F.2d 350, 158 U.S.P.Q. 210 (C.C.P.A. 1968), to establish the new non-statutory non-obvious category of double patenting in MPEP § 804 (II)(B)(2) is an improper reading of case law. Therefore, the PTO’s application of MPEP § 804 (II)(B)(2) to the present application constitutes an ultra vires action.

The Office Action rejects the claims of the present application under a non-statutory non-obvious double patenting rationale based on applicants’ existing patented inventions covered by four of its issued patents. The examiner bases this rejection on

section 804 (II)(B)(2) of the sixth edition of the MPEP. The sixth edition, initially published in 1996, is the first MPEP to instruct examiners on this “new” alleged type of double patenting, and permit rejections based on it. As the sole support for this new type of double patenting, the MPEP relies on In re Schneller, a 1968 Court of Customs and Patent Appeals decision. See M. P. E. P. § 804 (II)(B)(2) (6th ed. 1996)(citing In re Schneller, 397 F.2d 350, 158 U.S.P.Q. 210 (C.C.P.A. 1968)).

The PTO’s reading of Schneller as standing for the proposition that there exists a non-statutory non-obvious double patenting category represents an untenable interpretation of existing case law. As an initial matter, applicants will demonstrate that the PTO relies upon ambiguous statements in Schneller which one cannot even charitably term “dicta.” Next, Applicants will show that in the 28 years since the Schneller decision, no court, learned scholar, or prior PTO supervisory personnel have found Schneller to stand for the existence of a third type of double patenting. Finally, Applicants will demonstrate that Schneller represents a classic obviousness-type double patenting rejection recognized in leading cases such as In re Vogel, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970). Accordingly, Schneller does not create an additional type of double patenting.

- a. **The PTO’s decision to reject the application improperly relies on ambiguous statements in Schneller, not its holding.**

In section 804 (II)(B)(2) of the 6th edition of the MPEP, the PTO asserted for the first time a new non-statutory non-obvious double patenting rejection. Section 804 (II)(B)(2) of the 6th edition of the MPEP states:

There are some unique circumstances where it has been recognized that another type of non-statutory double patenting is applicable even where the inventions claimed in two or more applications/patents are considered non-obvious over each other. These circumstances are illustrated by the facts before the court in In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

M. P. E. P. § 804 (II)(B)(2) (6th ed. 1996). Schneller is the sole judicial underpinning cited as the basis for this conclusion. The MPEP further states:

In making an analysis for this type of non-statutory double patenting, the first question is: Is the subject matter recited in the claims of the application fully disclosed in the patent and covered by a claim in the patent? If the answer is no, double patenting does not exist. If the answer is yes, the second question is: Is there any reason why applicant was prevented from presenting the same claims for examination in the issued patent? If the answer is no, a double patenting rejection is appropriate.

M. P. E. P. § 804 (II)(B)(2) (6th ed. 1996).

MPEP section 804 (II)(B)(2) asks only the question of whether there was "any reason why applicant was prevented from presenting the same claims for examination in the issued patent." MPEP section 804 (II)(B)(2). For reasons explained in this response, this rationale for rejection is improper. In addition to the inquiries set forth in MPEP section 804 (II)(B)(2), the examiner in this Office Action asks the further question of whether the inventions in the present application and the issued patents are independent and distinct. This further inquiry does not exist in MPEP section 804 (II)(B)(2). For reasons explained in this response, this rationale for rejection is also improper.

To support the rejection based on the "independent and distinct" rationale, the examiner cites and relies in the Office Action on ambiguous statements of Schneller to justify the double patenting rejection. The examiner ignores the holding of Schneller in

an attempt to justify the double patenting rejection. The Office Action states that “[the] CCPA in Schneller used the ‘independent and distinct’ standard as the main factor in its determination that the double patenting rejection should be affirmed.” Office Action at page 20. Clearly, Schneller states that the invention claimed in the patent must be independent and distinct from the claims in the application. In re Schneller, 397 F.2d at 353-54. This statement, however, does not support the creation of a new type of double patenting. The Schneller court found that the claims in the patent “are ‘comprising-type’ claims, [and, therefore] they ‘cover’ both versions of the clip disclosed both in the patent and in the present application because they read squarely thereon.” In re Schneller, 397 F.2d at 354. These statements are clearly the first steps in support of a traditional obviousness double patenting analysis.

Neither the standard set forth in MPEP section 804 (II)(B)(2) nor the standard stated by the examiner in the Office Action is proper as will be explained in detail below.

In creating a third type of double patenting from the Schneller decision, the PTO and the examiner in this application rely on the CCPA’s statement that the Schneller facts did not present “the usual ‘obviousness-type’ double patenting case.” In re Schneller, 397 F.2d at 353-54. In making this statement, the Schneller court sought to distinguish the usual double patenting circumstance from the Schneller facts. The usual double patenting circumstance involves the addition or subtraction of an element from a patent’s claims, not the substitution of one element for another. Of course, the substitution of elements is the most common “obvious” inventive step. Accordingly,

Schneller does not create a third type of double patenting. The case is, in actuality, decided under the traditional two-type double patenting regime. Schneller is simply an obviousness-type double patenting case.

The impropriety of the PTO's current reading of Schneller is further amplified in the next two subsections, where applicants demonstrate that other scholars fail to find a basis for the PTO's expansive reading (as did the PTO itself for the 28 years following Schneller) and that the Schneller holding is clearly consistent with and supports the traditional two types of double patenting taught by leading cases like In re Vogel (422 F.2d 438, 164 USPQ 619 (C.C.P.A. 1970)).

b. The PTO remains alone in finding the existence of a non-statutory non-obvious double patenting standard for rejection.

Applicants submit that the case law supports only two types of double patenting. Thus, the non-statutory non-obvious third type, which the PTO applies, results from an improper reading of case law. The two types of double patenting supported by all case law, learned scholars, and respected authorities are: (1) same invention, or statutory, double patenting under 35 U.S.C. § 101; and (2) an obvious modification of the same invention, termed non-statutory obvious-type double patenting. The PTO remains alone in incorrectly finding that there exists an additional form of double patenting -- non-statutory non-obvious double patenting.

To applicants' knowledge, Schneller has been cited a total of six times in reported decisions in the 28 years since its issuance. No court has held that Schneller stands for the existence of a non-statutory non-obvious double patenting category. Further, none

of the cases citing Schneller make reference or inference to non-statutory non-obvious double patenting.¹ Furthermore, neither the Court of Customs and Patent Appeals, nor its successor court, the United States Court of Appeals for the Federal Circuit, have recognized the existence of a non-statutory non-obvious double patenting preclusion in cases not citing Schneller.

This absence of an acknowledgment of the existence of a so-called “third type” of double patenting in other double patenting cases is a strong indication that the Schneller holding is strictly confined to its factual situation and that its ambiguous language has no precedential value. In fact, the Federal Circuit’s behavior in the 28 years following the Schneller decision completely supports the applicants’ view that the PTO’s application of a non-statutory non-obvious double patenting represents an untenable reading of case law, and is, therefore, an ultra vires action by the PTO.

An examination of legal scholarship further supports the results found during the examination of case law: the PTO remains alone in incorrectly finding that there exists this additional non-statutory non-obvious form of double patenting, and that Schneller stands for such a proposition. With respect to learned patent law scholars, Applicants could provide a string of citations to support their contention that there

¹ The cases citing Schneller are: In re Goodman, 11 F.3d 1046, 1049 (Fed. Cir. 1993)(citing Schneller for the fundamental rationale underpinning double patenting); In re Braat, 937 F.2d 589, 595 (Fed. Cir. 1991)(citing Schneller for the fundamental rationale underpinning double patenting); Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 359 (Fed. Cir. 1986)(citing Schneller in a parenthetical citation to In re Zickendraht); In re Van Ornum, 686 F.2d 937, 943 (C.C.P.A. 1982)(citing Schneller to acknowledge the fundamental rationale underpinning double patenting); Union Carbide Corp. v. Dow Chemical Co., 619 F. Supp 1036, 1056 (D. Del. 1985)(quoting Schneller for the proposition that a patent resulting from a requirement to restrict is immune from a double patenting rejection); and Kaz Manufacturing Co., Inc. v. Northern Electric Co., 412 F. Supp 470, 486 (S.D.N.Y. 1976)(citing Schneller for the proposition that only the claims should be looked at for a double patenting rejection, and that invention claimed must be independent and distinct).

exists only two types of double patenting. The point, however, is sufficiently demonstrated with examples from three of the most respected scholars in the field: Donald S. Chisum, Robert L. Harmon, and Peter D. Rosenberg. Each author examines the patent examination process from a different perspective: professor, practitioner, and examiner, respectively. Professor Chisum in his patent treatise states “[i]n a line of cases beginning in 1964, the Court of Customs and Patent Appeals developed a distinction between two types of double patenting.” (emphasis added) 3 Donald S. Chisum, Patents § 9.03[3][a] (Rel. 5.5 1995). Professor Chisum, describes the two types of double patenting with a discussion of the 1970 Vogel decision. Id. (citing In re Vogel, 422 F.2d 438, 164 U.S.P.Q. (BNA) 619 (C.C.P.A. 1970)). Patent practitioner Harmon in his text describes only two types of double patenting when he states “[t]he doctrine that forbids so-called double patenting precludes one person from obtaining more than one valid patent for either (1) the same invention, or (2) an obvious modification of the same invention.” Robert L. Harmon, Patents and the Federal Circuit, § 15.5 (3d ed. 1994). Examiner Rosenberg in his patent law treatise states “there are two types of double patenting: (1) the ‘same invention’ type . . . and (2) the ‘obviousness’ type . . .” 2 Peter D. Rosenberg, Patent Law Fundamentals, § 15.05 (2d ed., Rel. 35 1995). Clearly, there exists a broad consensus among learned scholars in all cross-sections of patent law that the law of double patenting contains two and only two types of double patenting.

Further, applicants’ search of relevant literature finds no discussion addressing a third type of double patenting. Applicants have searched each issue of the Journal of

the Patent [& Trademark] Office Society, arguably the most complete and respected periodical addressing patent law issues, from the date of the Schneller decision in 1968 to the present. Applicants report that their efforts have uncovered not a single article addressing the topic or case. In Applicant's view, if Schneller represents the monumental change in jurisprudence that the PTO asserts, the case would have been the subject of at least one article, comment or note, letter to the editor, or footnote – yet none occurred. Applicants assert it is crystal clear that since the time of the Schneller decision, the parties involved in the case, contemporaries in the field, the deciding court's clerks, students, examiners, academics, and practitioners, did not view the case a paradigm shift, but rather another routine case addressing obviousness-type double patenting, not worthy of specific attention.

Finally, for 28 years following the Schneller decision, the PTO itself did not view the case as a major shift in principle. The previous editions of the MPEP explicitly describe double patenting on the same basis as that applicants urge in this response: "There are two types of double patenting rejections. One is the 'same invention' type double patenting rejection . . . [t]he other type is the 'obviousness' type double patenting rejection . . ." MPEP § 804 (II)(B)(2) (5th ed., rev. 16, 1994). The discussion of Schneller in the sixth edition of the MPEP is the first appearance of this case in the MPEP. Two entire editions, and numerous revisions within each edition of the MPEP have been issued since 1968 without a mention of Schneller or the concept of non-statutory non-obvious double patenting. Applicants contend that the current PTO revisionism based on Schneller results from a misguided reliance on ambiguous

statements, as discussed supra. Further, as demonstrated infra, the Schneller holding is a classic obviousness-type double patenting decision.

c. **Schneller does not support the creation of a third type of double patenting.**

The PTO's reliance on Schneller to establish a third-type of double patenting is totally misplaced. When properly read, Schneller fits into the well established double patenting regime disclosed in leading cases such as Vogel. For completeness, Applicants will first review double patenting as it currently exists. Next, applicants will demonstrate that Schneller is a case decided under non-statutory obviousness type double patenting.

i. **The two existing types of double patenting are well established in sound case law.**

The first type of double patenting, "same invention double patenting", finds its support in the language of 35 U.S.C. § 101 which states that whoever invents or discovers any new and useful process "may obtain a patent therefore . . ." In re Longi, 759 F.2d 887, 892 (Fed. Cir. 1988). The test for same invention double patenting is based on asking the question: "Is the same invention being claimed twice?" In re Vogel, 422 F.2d 438, 441 (C.C.P.A. 1970). To answer this question it is helpful to determine "whether one of the claims [being compared] could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention." Id.

The second type of double patenting is a "judicially created doctrine intended to prevent improper timewise extension of the patent right by prohibiting the issuance of

claims in a second patent which are not ‘patentably distinct’ from claims of a first patent.” In re Braat, 937 F.2d 589, 592 (Fed. Cir. 1991)(citing In re Longi, 759 F.2d at 887). This doctrine prohibits “claims in the second patent which define merely an obvious variation of an invention claimed in first patent.” Id. This type of double patenting rejection is analogous in operation to 35 U.S.C. § 103 “except that the patent principally underlying the double patenting rejection is not considered prior art.” In re Longi, 759 F.2d at 892, n.4 (citing In re Braithwaite, 379 F.2d 594, 600 n.4, 54 C.C.P.A. 1589, 154 U.S.P.Q. (BNA) 29 (C.C.P.A. 1967)). Obviousness type double patenting is a question of law. In re Goodman, 11 F.3d 1046, 1051, 29 U.S.P.Q.2d (BNA) 2010 (Fed. Cir. 1993); Texas Instruments Inc. v. International Trade Commission, 988 F.2d 1165, 1179, 26 U.S.P.Q.2d (BNA) 1018, 1029 (Fed. Cir. 1993).

The test for obviousness type double patenting is based on the question: “Does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent?” In re Vogel, 422 F.2d at 441. The question is answered by determining if the claim in the pending application would be obvious in view of the claims in the patent. In re Longi, 759 F.2d at 893 (citing Carman Industries Inc. v. Wahl, 724 F.2d 932, 940, 220 U.S.P.Q. (BNA) 481, 487, n.5 (Fed. Cir. 1993)). In making the determination, one may not use the patent disclosure itself as prior art. Id.; In re Aldrich, 398 F.2d 855, 158 U.S.P.Q. (BNA) 311 (C.C.P.A. 1968); In re Boylan, 392 F.2d 1017, 157 U.S.P.Q. (BNA) 370 (C.C.P.A. 1968). Objective indications may also be considered as with a 35 U.S.C. § 103 rejection analysis.

- ii. **Schneller was decided under non-statutory obviousness double patenting and thus does not create an extraneous third category.**

Schneller's holding is clearly a part of the existing two type double patenting regime. The court in Vogel established the two part test, discussed supra, for analyzing double patenting. The first inquiry relates to statutory double patenting and asks whether the same invention is being claimed twice. The test is whether one of the claims of the application can be literally infringed without infringing one of the claims of the existing patent, and vice versa. If the answer is no, then double patenting does not exist.

The existing patent in Schneller claimed a clip comprising the elements A, B, C, and X. The application claimed a clip with elements A, B, C, X, and Y. Applying the test for statutory double patenting to the facts in Schneller, the A, B, C, X, and Y claim would literally infringe the claim of the patent because of the open language in the patent claim. The claim in the patent, however, would not literally infringe the claim in the application. There is no statutory double patenting.

The obviousness-type double patenting asks whether any claims in the application merely define an obvious variation of an invention disclosed and claimed in the patent. Here, objective indications can be used to prove obviousness. The Schneller invention related to a wire clip for attaching lath sheets to a structural framing member. Elements A, B, and C, known in the prior art, were an elongated body, a loop portion, and a prong respectively. Schneller, 397 F.2d at 354. Element X was a leg offset from the prong, and element Y was a lip to secure the edge of the next sheet of lath. Id. The Schneller patent disclosed elements A, B, C, X, and Y as the best mode and claimed elements A, B, C, and X. Id. The application claiming elements A, B, C, and Y and

elements A, B, C, X, and Y would be obvious to one skilled in the art. Making the new combination would merely exercise skill or ingenuity expected of a person with ordinary skill in this art because X and Y were known to the art. The patent application of Schneller was rejected under the obviousness-type double patenting test as defined in Vogel, which is the currently used test.

In finding a third type of double patenting in the Schneller factual situation, the PTO relies on the court's discussion that the facts did not present "the usual 'obviousness-type' double patenting case." In re Schneller, 397 F.2d at 353-54. This statement, however, represents the deciding court's commentary regarding the uniqueness of the factual circumstances surrounding the element composition of the application. Specifically, the court's statement means that the unusual nature of the case was that of the substitution of element X for element Y, not the addition or subtraction of an element from the patent's claims. The substitution of elements is the most common form of obviousness. Schneller does not create a third type of double patenting. The case itself was in actuality a case decided under the two-type double patenting regime.

In sum, as demonstrated supra, the PTO has improperly interpreted Schneller to stand for a proposition for which it does not. The general notion of the existence of a non-statutory non-obvious double patenting has not been located in any learned publication or existing case law. The PTO's reliance upon Schneller to establish the new non-statutory non-obvious category of double patenting is an improper reading of case law. The rule promulgated by the PTO is, therefore, not related to the purposes of the

enabling legislation -- it is a plain violation of it. Applicants remind the examiner that in the event of a disagreement between the MPEP (and its application) and existing case law, the examiner (as well as the PTO Board of Appeals) has an obligation to follow the case law. Ex parte Hartman, 186 U.S.P.Q. (BNA) 366, 367 (Pat. & Trademark Off. Bd. App. 1974). The PTO Commissioner has clearly acted ultra vires to his statutory authority granted under 35 U.S.C. § 6(a). This act is not in accordance with law and, therefore, must be viewed as an ultra vires action under 5 U.S.C. § 706(2)(A).

2. The Office Action attempts to use language in Schneller to support the application of the long discredited doctrine of late claiming

In the outstanding Office Action, Schneller is cited to support the proposition that there exists no apparent reason why applicants were prevented from presenting claims corresponding to those of the present application during prosecution of the parent applications which matured into patents. Applicants submit that the Office Action attempts to use language in Schneller to support the long discredited doctrine of late claiming. The Court of Customs and Patent Appeals has addressed this point in the years following Schneller.

a. Late claiming is a long discredited doctrine

The discredited doctrine of late claiming was once improperly employed to refer to the alleged failure of a patent applicant to "timely" claim all of the subject matter that is disclosed in the specification of his or her initial application. See, e.g., Westphal v. Fawzi, 666 F.2d 575 (C.C.P.A. 1981). United States Code Title 35 Section 120 contains the provision in the patent laws for continuation applications. A continuation application permits the applicant to submit additional claims in a subsequent

application which are supported by the disclosure in the original application's specification. A proper continuation application and its original application, known as the "parent" of the continuation application, are considered "parts of the same transaction, and both as constituting one continuous application, within the meaning of the law." In re Hogan, 449 F.2d 595, 603 (C.C.P.A. 1977)(quoting Godfrey v. Eames, 68 U.S. 317, 325-6 (1864)); Square Liner 360 Degrees, Inc. v. Chisum, 691 F.2d 362 (8th Cir. 1982)(same). Thus, the continuation application is afforded the benefit of the priority of the filing date of the parent application as to all prior art. Numerous controlling court decisions have squarely held that a claim may be written and presented at any point in a sequence of patent applications, so long as it is supported by the original specification of the "parent" application. The Westphal case is illustrative. In a dispute between two inventors as to the priority of the invention, the Westphal court determined that an application raising new claims for compounds useful as herbicides, seeking the benefit of a parent application's filing date of eight years earlier, had priority over claims filed by the competing inventor, whose patent application was submitted after the date of the other inventor's parent application. Westphal, 666 F.2d at 576. This was so despite the competing inventor's contention that the claims had been submitted "late," and therefore, should not have been issued as a patent. Id. at 576-77.

The CCPA held that the subsequent applicant's contention of late claiming did not affect his right to claim the benefit of the earlier filing date. Id. at 577. That he "couch[ed] his argument in non-statutory 'late claiming' terms," like the Office Action here, was "of no moment." Id. The court articulated the now settled rule of law: "later submitted claims need only be reviewed for support in the original disclosure under § 112, first paragraph."²

² Section 112, first paragraph is expressly incorporated into 35 U.S.C. § 120, which is the continuation procedure under the patent laws. Section 112, first paragraph provides:

Therefore, “[i]f Westphal had presented a ‘late claiming’ argument properly understood, it would have raised only the question of whether [Fawzi] had adequate support in his [original] disclosure, as of its filing date, for the later-submitted . . . claims.” Id. Because there was adequate support under section 112, first paragraph in the parent application, the priority was upheld, and the “late claiming” doctrine was rejected, as it was “not a viable doctrine.” Id. at 578.

The Federal Circuit adopted the CCPA’s view of “late claiming” quite early in its jurisprudence in Correge v. Murphy, 705 F.2d 1326 (Fed. Cir. 1983), observing that Westphal had rejected the doctrine and noting that “[i]n light of the sufficiency of the disclosure [a party] can not raise any so-called ‘late claiming’ issue.” Id. at 1329, n. 4. Thereafter, the Federal Circuit has consistently maintained this position. In an opinion one year later in Railroad Dynamics Inc. v. A. Stucki Co., 727 F.2d 1506 (Fed. Cir. 1984), the Federal Circuit reinforced its rejection of the late claiming doctrine, and observed that it can come dressed in a variety of disguises:

RDI included among its plethora of defenses one to which it applied at trial the inappropriate and long ago discredited “late claiming” label. Because Stucki had amended its claims in the course of prosecuting its application, RDI created from that single fact, four variously labeled “defenses” As the District Court correctly recognized, the sole question raised by that single, but variously stated defense is whether the claims entered by amendment were supported by the disclosure in Stucki’s original application. . . . RDI’s argument that the patent should be held invalid in light of this many-labeled defense is and always was without merit.

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Thus, the claims of the subsequent continuation application under section 120 must be supported, as described above, in the parent application’s specification.

Railroad Dynamics Inc., 727 F.2d at 1517.

Still later, the Federal Circuit upheld a district court decision rejecting a claim of unnecessary delay in obtaining a patent in Studiengesellschaft Kohle v. Northern Petrochemical Co., 784 F.2d 351 (Fed. Cir. 1986). The patent in Studiengesellschaft Kohle involved a process for making polypropylene, the parent application of which was filed in 1955. Id. at 352. Because of three patent interferences involving the application, prosecution of the application was stayed in the PTO for 16 years, from 1961 until 1977. Id. at 353. Notwithstanding this, however, the District Court held that Studiengesellschaft Kohle had not violated or exceeded the time period limits provided by the patent statute. Id. at 356. The Federal Circuit, therefore, affirmed the lower court's decision. Id.

A recent decision of the Patent Office Board of Appeals, Ex parte Hyatt, No. 91-0984 (March 16, 1992)(Ex. 2), also has followed the Federal Circuit's lead. Notwithstanding a delay of nine years between the filing of the continuation application and the original filing, the Board of Appeals held that "[i]t appears to us that the Applicant has done what is provided for in the statute and relevant rules and practice of the [PTO] in filing the present continuing application. 35 U.S.C. section 120 does not place a time limit on filing the continuing application. Rather, all that is required to preserve an earlier effective filing date as to common subject matter is copendency or a continuous chain of copendency." Id. at 8. Accordingly, the Patent Board of Appeals reversed the rejection of claims on the basis of purported pre-issuance laches. Id. at 9.

The only relevant inquiry concerning claims filed in a subsequent continuation application pursuant to 35 U.S.C. section 120 is whether they are adequately supported under 35 U.S.C. section 112, first paragraph, in the initial application. If the support exists, the inquiry is at an end. The Office Action's statement that "there is no apparent reason why applicants were prevented from presenting claims corresponding to those of the instant application during prosecution of the parent applications which matured into patents", presents no valid justification for a non-statutory non-obviousness double patenting rejection. Office Action at page 19.

Nothing in 35 U.S.C. section 120 requires that an applicant assert in the originally-filed application, claims to every invention disclosed therein. Indeed, that is the very purpose and function of section 120. So long as the continuation application is "filed before the patenting or abandonment or of termination of proceedings" on the parent application, section 120 does not require that claims to an invention be filed within any particular time limit.

Furthermore, although other sections of the Patent Act contain time limits, there are no time limits specified in sections 120 or 121. The wide latitude given to applicants for filing continuation or divisional applications is not accidental. Where there is a danger of abusive delay, the Patent Act specifically sets time limits which must be strictly obeyed.³

³ Other time limits in the Patent Act provide important contrasts to the absence of any time limit in section 120. Section 133, for example, requires Applicants to respond to Office Actions by the PTO within six months or the application is deemed abandoned. Section 135 limits to one year the time period in which an applicant may copy claims from an issued patent in order to provoke an interference action (a proceeding in the PTO to have patented claims transferred to the applicant instead of the patentee).

Also, the language of sections 120 and 112, first paragraph are unambiguous. "Unless exceptional circumstances dictate otherwise, '[w]hen [a court] find[s] the terms of a statute unambiguous, the judicial inquiry is complete.'" Burlington Northern Railway Co. v. Oklahoma Tax Comm'n, 481 U.S. 454, 461 (1987). Indeed, "[a]cceptance of [defendants'] position would require recognition of a nonstatutory exception to the clear language of section 120." In re Bauman, 683 F.2d 405, 407 (C.C.P.A. 1982). This is not permissible.

At various times, infringers or competing inventors have proposed grafting time restrictions onto section 120 based on the number of continuations, the term of any patent issuing from a continuation, or the overall length of pendency of the series of applications. In each and every instance the courts have rejected such intentions.

b. There is no limit on the length of pendency of a chain of continuation applications.

In In re Hogan, 559 F.2d 595 (C.C.P.A. 1977), the CCPA was faced with a chain of continuation applications extending over twenty-four years, and a contention that invalidating prior art should overcome the claim of priority for that chain of applications despite compliance with section 120. Id. at 597. Despite this, the CCPA held that the only question at issue was whether the initial application provided

Additionally, sections 251 and 252 codify a two-year limit during which the patentee may apply for a broadening "reissue" of originally issued patent claims, which may afford an infringer of the broader, reissued claims a possible "intervening rights" protection, a laches-type defense. Accordingly, Congress knows how to impose time limits in the provisions of the Patent Act when it chooses to do so. The conspicuous absence of any such time limits in section 120, therefore, cannot be deemed an oversight. See *infra* at 24.

adequate support for the subsequent continuation applications under section 112, first paragraph. *Id.* at 603-04.

The very purpose of the reliance on section 120, the court observed, was to “reach back” to the original filing date to “avoid the effect of intervening [prior art] references.” *Id.* at 604. To do otherwise would “render the ‘benefit’ of 35 U.S.C. § 120 illusory.” *Id.* In fact, to judge such a continuation application “in isolation,” without a relation back to the original filing “would have a chilling effect upon the right of the applicants to file continuations.” *Id.* at n.13. Thus, although the Court noted that “the 24 years of pendency herein may be decried, . . . a limit upon continuation applications is a matter of policy for Congress, not for us.” *Id.* “As presently constituted, the law set forth in 35 U.S.C. §§ 112 and 120 is the same for all applications, whether of long or short pendency.” *Id.* “The clear and unambiguous language of § 120 states” that an adequately supported continuation application “shall have the same effect, as to such invention, as though filed on the date of the prior application” *Id.* at 604. The later application [1971], therefore, “should have been tested for compliance with § 112, first paragraph, ‘as though filed on the date of the prior application [1953].’” *Id.* at 604.

c. **There is no limit on the number of continuation applications an applicant may file.**

Similarly, in *In re Henricksen*, 399 F.2d 253 (C.C.P.A. 1968), the CCPA was faced with a series of six continuation applications pending for over 18 years. Significantly, unlike Harvey’s continuation applications -- each of which resulted in an issued patent -- all four of the intermediate continuation applications of Henricksen, were ultimately

abandoned. Id. at 255. Notwithstanding this, the CCPA stated that “[t]he sole issue presented by this appeal is the interpretation of 35 U.S.C. § 120.” Id. at 253-54. After a detailed review of the legislative history of section 120, the Court expressly held that “there is no statutory basis for fixing an arbitrary limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of copending applications, provided [the] applicant meets all the other conditions of the statute.” Id. at 254.

Thus, the basic requirements of section 120 have been summarized as: (1) copendency (i.e., the later filed application must be filed before “the prior application” is patented, abandoned or the proceedings are terminated); (2) continuity of disclosure (i.e., it relies upon and is supported by the parent application’s specification); (3) coinventorship (i.e., the subsequent application lists the same inventor(s) as the parent); and (4) specific reference to the earlier application (i.e., the continuation application references the parent). See In re Bauman, 683 F.2d 405, 407 (C.C.P.A. 1982).

d. The legislative history of section 120 makes clear that the absence of limitations was purposeful.

The legislative history of section 120 of the Patent Act also supports the notion that the absence of a time limit in that provision is not an oversight. A preliminary draft of section 120 had proposed that “[t]he term of the patent granted on said later application shall not extend beyond the date of expiration of the patent, if any, which may be granted on the earlier application.” Congress, however, specifically deleted that provision from section 120 before its enactment. See In re Bauman, 683 F.2d at 410 n.12. In Bauman, the CCPA held that “the deletion of this provision” in the final version of section 120 “indicates that Congress did not intend limitations such as patent expiration

date with that of the patent issued on the parent application to be imposed on the patent issuing on the continuation application.” *Id.*

Similarly, in Studiengesellschaft Kohle the Federal Circuit rejected a request that the court require the second issued patent term be limited to the term of the first. In declining to do so, the Federal Circuit stated that “Congress, in 1952, refused to truncate the term of patents issued [on separate inventions issuing from a single parent application], although the question was squarely before it.” *Id.* at 357 (citing In re Bauman). The Federal Circuit also observed that “we are without authority to set our own arbitrary limit” to the length of a patent issuing from a continuation. *Id.* at 356.

As the CCPA observed, “a limit[ation] on continuing applications is a matter of policy for Congress, not for us.” See In re Hogan, 559 F.2d 595, 604 (C.C.P.A. 1977). The rights granted are defined by the statute, not by the discretion of the PTO or the courts:

A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural but of purely statutory right.

Id. (quoting U.S. v. American Bell Telephone Co., 167 U.S. 224, 247 (1897).⁴

Moreover, the CCPA has explained its reluctance to impose a limitation on the continuation process defined in section 120, in part, because it would amount to a retroactive rule change” that could divest patentees of “valuable rights to which . . . they were entitled.” In re Henriksen, 399 F.2d 253, 262 (C.C.P.A. 1968).

The appropriate remedy that is provided by section 120 is not the Office Action’s non-existent “claims presentation delay”, therefore, but rather a detailed determination

⁴ In another case, the CCPA observed, that “it is unfortunate that a patent should be granted on an application depending on another application filed over 20 years ago . . . but the cure for this deplorable state of affairs rests with Congress, not with us.” In re Henriksen, 399 F.2d 253, 262 (C.C.P.A. 1968). Thus, “it is our view, as the judiciary, that it is for the Congress to decide, with the usual opportunity for public hearing and debate, whether such a restriction . . . is to be imposed.” *Id.*

of whether the subsequent claims are supported by the original disclosure in the parent application.

e. **Applicants are in full compliance with section 120 of the Patent Act.**

Applicants have fully complied with the requirements of section 120. These facts are undisputed. Moreover, under the law, the issuance of the applicants' other applications as patents presumes that this has occurred.

First, the present application was filed before a patent issued from the preceding application. The present application identified the same co-inventors of the inventions. The present application contains a specific reference to the parent application. Finally, the present application complies with the disclosure requirements of section 112, first paragraph. Therefore, compliance with section 120 is complete.

The Office Action's statements as to whether applicants could have presented their claims earlier, are simply nothing more than the discredited "late claiming" doctrine which has no basis in law.

3. **Assuming arguendo That Schneller Creates A Third Category Of Double Patenting, It Is Very Narrow And Distinct, And Does Not Apply To The Application.**

a. **The factual background of Schneller.**

Schneller disclosed an invention relating to a wire clip with two features (X and Y) that could be used separately or in combination. In re Schneller, 397 F.2d at 354. Three elements (A, B, and C) of the invention were known in the prior art. Id. The best mode of Schneller's invention was to use the two features in combination (A, B, C, X, and Y). Id. The patent claimed a wire clip comprising elements A, B, C, and X. Id. A divisional application claiming a wire clip comprising ABCY and ABCXY was voluntarily filed by Schneller. Id. The court found no reason why Schneller voluntarily sought this division method of claiming his invention in separate applications, instead

of claiming it in the application in which he first disclosed it. The court then went on to state that “[t]his is not a case of an improvement or modification invented after filing. Id. Hence it is not the usual ‘obviousness-type’ double patenting case. Neither is it a ‘same-invention-type’ double patenting case” In re Schneller, 397 F.2d at 353-54. “[E]ven a minimal concern for the public interest requires an Applicant to establish that the inventions are in fact independent and distinct and hence that the grant of a patent on the later application will not result in a timewise extension of the protection afforded by his earlier patent.” Id. at 354. “The fact is that since . . . they are ‘comprising-type’ claims, they ‘cover’ both versions of the clip disclosed in the patent and in the present application because they read squarely thereon.” Id. The court stated that the dispositive issue included whether the patent protection for the clips, fully disclosed in and covered by the claims of the patent, would be extended by allowance of the appealed claims. Id. at 355. On this basis, the Schneller court affirmed the double patenting rejection. Id.

b. The Office Action fails to explicitly meet the narrowly defined requirements for double patenting under MPEP § 804 (II)(B)(2).

The Office Action fails to provide a proper and complete claim analysis to demonstrate double patenting under the standard articulated in MPEP § 804 (II)(B)(2). The Office Action fails to demonstrate how the specific elements of any specific claim of any existing Harvey patent reads on the specific elements of a specific claim of the present Harvey application. In Schneller, the Court specifically cited both the elements in the claims in the patent and the elements in the claims in the application of Schneller. The Court then discussed how the claims in the patent read on the claims in the application and thus justified a double patenting rejection. The Office Action fails to do this in the rejection. The Office Action justifies the rejection based on parts of applicants’ total disclosed system or process as opposed to specific elements in specific

claims. The Office Action states that since these “parts” are parts of the overall system, claims to one part cover the other parts under MPEP § 804 (II)(B)(2). Office Action, at page 24. The Office Action contains no specific detailed comparisons, but states that the patented claims recite limitations interrelated with similar features of the application claims, and both of these claimed features describe the preferred embodiment. This fails to meet the PTO’s burden of proving double patenting under section 804 (II)(B)(2) of the 6th edition of the MPEP.

The Office Action employs the language and words of the claims as prior art against the applicants. This tactic is an incorrect method of supporting a double patenting rejection. As the Federal Circuit recently acknowledged, “it is important to bear in mind that comparison can be made only with what invention is claimed in the earlier patent, paying careful attention to the rules of claim interpretation to determine what invention a claim defines and not looking to the claim for anything that happens to be mentioned in it as though it were a prior art reference.” General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1280-81; 23 U.S.P.Q.2d (BNA) 1839, 1845-46 (Fed. Cir. 1992). Specifically, words in the claims “are looked to solely for the purpose of determining what has already been patented. They are not treated as prior art [because] they are no more ‘prior art’ under the statute than the specification.” In re Sutherland, Jr., 347 F.2d 1009; 52 C.C.P.A. 1683, 146 U.S.P.Q. (BNA) 485 (C.C.P.A. 1965). Additionally, it remains impermissible to use the patent disclosure as prior art to support a double patenting rejection. In re Kaplan, 789 F.2d 1574, 1580; 229 U.S.P.Q. (BNA) 678 (Fed. Cir. 1986); In re Vogel 422 F.2d at 441. Further, the interrelationship of claims is not a basis of rejection for double patenting. Interrelationship of claims among different patents of the same inventor remains a frequent occurrence, as noted by one court: “The exigencies of prosecution commonly compel the issuance of interrelated applications with overlapping disclosures at widely divergent times.” In re Saret, 327

F.2d 1005, 1011; 51 C.C.P.A. 1180, 1189; 140 U.S.P.Q. (BNA) 474 (C.C.P.A. 1964). The Office Action fails to demonstrate where the specific elements of any specific claim of an existing Harvey patent reads on the specific elements of a specific claim of the Harvey application. The Office Action fails to provide sufficient basis for a double patenting rejection under MPEP § 804 (II)(B)(2).

Applicants submit that the Office Action misapplies the facts and holding in Schneller to the application and existing patents. The MPEP is relying on ambiguous statements in Schneller. The court in Schneller based its decision on the transitional term “comprising” used in the patent claims. In patent law, the word “comprises” has been construed to mean “including the following elements but not excluding others.” Moleculon Research Corp. v. CBS, Inc., 229 U.S.P.Q. (BNA) 805, 812 (Fed. Cir. 1986). The patent in Schneller contained claims to a wire clip comprising elements A, B, C, and X. The court in Schneller held that this claim read on the claim in the application of a wire clip comprising elements A, B, C, X, and Y. With respect to the pending application, however, the Office Action makes no reference to any specific element of a Harvey patent claim. Rather, the Office Action speaks in generalities with use of the transitional term “comprising.”

The Office Action acknowledges that the specific claim limitations in the application have not been claimed in the patents. Office Action, at page 23. The Office Action also states that because the patent claims were directed to parts of applicants' total disclosure, the recitation of comprising enables those patented claims to cover claim features recited in applicants' present application claims. Office Action, at page 23. The Office Action asserts that since the headend, intermediate, and subscriber stations are part of the overall system, claims to one part cover the other part under the Schneller decision. Office Action, at page 24. Plainly, this constitutes a misapplication of Schneller.

Schneller does not in any way suggest or imply that a ‘part’, ‘group’, ‘type’, or ‘class’ of claims that are part of an overall system can be used against each other as prior art for a double patenting rejection en masse. Schneller analyzed the elements of the claims of the patent and the application to determine if a double patenting rejection was appropriate. The Office Action misapplies Schneller in the rejection.

c. The Claims in the Present Application are Distinct From the Claims in the Patents

As an initial matter, the examiner’s rejection of the present application under the Schneller double patenting theory based on Harvey U.S. Patents 4,694,490 and 4,704,725 is improper because the present application does not claim the benefit of those applications under 35 U.S.C. § 120. Thus, there could never have been a basis for claiming the present subject matter in those applications. Therefore, the rejection based on Harvey U.S. Patents 4,694,490 and 4,704,725 should be withdrawn.

However, the PTO fails to specifically identify all claims from cited Harvey patents that cover specific claims in the present application. Rather, the Office Action references “representative claims” from patents and the present application. The Office Action does not cite specific elements from claims in a patent covering specific elements in claims in the application. In fact, the Office Action acknowledges that the patent claims and application claims are directed to different elements, but states that this “does not prohibit this rejection if there is common or interrelated subject matter recited.” Office Action, at page 24. The Office Action then references Schneller in support of this erroneous statement, not supported by Schneller.

The claims in the present application are distinct from the claims in the Harvey patents. As previously mentioned, the Office Action states that the independent and distinct standard was the main factor in the Schneller Court's determination that the double patenting rejection should be affirmed. Office Action, at page 20. The Office Action has misinterpreted this phrase. This phrase means independent 'or' distinct. MPEP (6th ed.) § 802.01. The MPEP defines independent as meaning "that there is no disclosed relationship between the two or more subjects disclosed" and that they are not connected. Id. The MPEP defines the term distinct as meaning that "two or more subjects disclosed are related . . . but are capable of separate manufacture, use, or sale as claimed . . ." Id. Two or more subjects cannot then be unrelated, independent, and also related, and thus distinct. Analyzing the PTO's cited representative claims referenced in the Office Action, the claims of the present application are clearly distinct from the claims in the patents and therefore the claims in the present application are patentable. Although not required, applicants will analyze the claims of the present application with respect to the designated representative claims of Harvey U.S. Patents 4,694,490 and 4,704,725.

i. **First representative claim, claim 7 of U.S. patent 4,694,490, covering present application claim 4**

Claim 7 of U.S. Patent No. 4,694,490 covers a method of communicating television program material, said material including a video signal containing a television program and an instruct-to-overlay signal, to multiple receiver stations. The video signal is received and the instruct-to-overlay signal detected and processed by a computer. The computer generates and transmits its overlay video signals to a television receiver which presents a combined display of the television program and

overlay video signals, said display specific to a specific user. Present application claim 4 relates to a method of controlling a remote intermediate data transmitter station to communicate data to one or more receiver stations. One or more instruct signals are received and delivered to a transmitter, the instruct signals being effective at a receiver station to generate a schedule and to output mass medium program materials in accordance with the schedule. One or more control signals are received, which at the remote intermediate data transmitter station operate to control the communication of the instruct signals. The control signal(s) are transmitted before a specific time.

Patent claim 7 relates to presentation of overlay signals combined with a television program. Present application claim 4 relates to the control of a remote intermediate data transmitter station. Present application claim 6 does not directly address or infer the concept of overlay signals at all. Patent claim 7 does not directly address or infer the concept of controlling a remote intermediate data transmitter station. Patent claim 7 does not cover present application claim 6. The two claims are capable of separate manufacture, use, and sale as claimed. These two inventions are distinct.

U.S. Patent 4,694,490, Claim 7	Present Application, Claim 4 (Amended)
In a method of communicating television program material to a multiplicity of receiver stations each of which includes a television receiver and computer, the computers being adapted to generate and transmit overlay video signals, to their associated television receivers, said overlay signals causing the display of user specific information related to said program material, and with at least some of said computers being programmed to process overlay modification control signals so as to modify the overlay video signals	A method of controlling a remote intermediate data transmitter station to communicate data to one or more receiver stations, with said remote transmitter station including a broadcast or cablecast transmitter for transmitting one or more signals which are effective at a receiver station to instruct a computer or processor, a plurality of selective transmission devices each operatively connected to said broadcast or cablecast transmitter for communicating a unit of data, a data receiver, a control signal detector, and a controller or computer capable of

transmitted to their associated receivers, each of said computers being programmed to accommodate a specific user application, and wherein a video signal containing a television program signal and an instruct to-overlay signal are transmitted to said receiver stations, the steps of:

receiving said video signal at a plurality of receiver stations and displaying said program material on the video receivers of selected ones of said plurality of receiver stations

detecting the presence of said instruct-to-overlay signal at said selected receiver stations at a time when the corresponding overlay is not being displayed, and coupling said instruct-to-overlay signal to the computers at said selected receiver stations, and

causing the computers at said selected receiver stations to generate and transmit their overlay video signals to their associated television receivers in response to said instruct-to-overlay signal, thereby to present a combined display at the selected receiver stations consisting of the television program and the related computer generated overlay, the overlays displayed at a multiplicity of said receiver stations being different, with each display specific to a specific user.

controlling one or more of said selective transmission devices, and with said remote transmitter station adapted to detect the presence of one or more control signals, to control the communication of specific instruct signals in response to detected specific control signals, and to deliver at its broadcast or cablecast transmitter one or more instruct signals, said one or more instruct signals being effective at a receiver station to generate a schedule and to output mass medium program materials in accordance with said schedule, said method of controlling [communicating] comprising the steps of:

(1) receiving said one or more instruct signals to be transmitted by the remote intermediate data transmitter station and delivering said one or more instruct signals to said [a] transmitter[, said one or more instruct signals being effective at a receiver station to generate a schedule and to output mass medium program materials in accordance with said schedule];

(2) receiving said one or more control signals which at the remote intermediate data transmitter station operate to control the communication of said one or more instruct signals; and

(3) transmitting said one or more control signals to said transmitter before a specific time.

ii. **Second representative claim, U.S. patent 4,704,725, claim 3 covering present application claim 4**

Claim 3 of U.S. Patent No. 4,704,725 covers a method of communicating output signals comprising data and user specific signals at a multiplicity of receiver stations from computers to output devices. At least some of the computers can modify the user specific signals by processing modification control signals. The computers communicate the data and user specific signals in response to a received and detected

instruct-to-transmit signal. Present application claim 4 relates to a method of controlling a remote intermediate data transmitter station to communicate data to one or more receiver stations. One or more instruct signals are received and delivered to a transmitter, the instruct signals being effective at a receiver station to generate a schedule and to output mass medium program materials in accordance with the schedule. One or more control signals are received, which at the remote intermediate data transmitter station operate to control the communication of the instruct signals. The control signal(s) are transmitted before a specific time.

Patent claim 3 relates to the communication of user specific signals. Application claim 4 relates to controlling a remote intermediate data transmitter station. A signal and controlling a data transmitter station are separate and distinct items that serve different purposes and functions. Application claim 4 does not directly address or infer the communication of user specific signals. Patent claim 3 does not directly address or infer the concept of controlling a remote intermediate data transmitter station. Patent claim 3 does not cover present application claim 4. The two claims are capable of separate manufacture, use, and sale as claimed. These two inventions are distinct.

U.S. patent 4,704,725, claim 3	Present Application, Claim 4 (Amended)
<p>A method of communicating data to a multiplicity of receiver stations each of which includes a computer adapted to generate and transmit user specific signals to one or more associated output devices, with at least some of said computers being programmed to process modification control signals so as to modify the user specific signals transmitted to their associated output devices, each of said computers being programmed to accommodate a special user application, comprising the steps of: transmitting an instruct-to-transmit</p>	<p>A method of controlling a remote intermediate data transmitter station to communicate data to one or more receiver stations, with said remote transmitter station including a broadcast or cablecast transmitter for transmitting one or more signals which are effective at a receiver station to instruct a computer or processor, a plurality of selective transmission devices each operatively connected to said broadcast or cablecast transmitter for communicating a unit of data, a data receiver, a control signal detector, and a controller or computer capable of</p>

signal to said computers at a time when the corresponding user specific information is not being transmitted to an output device;

detecting the presence of said instruct-to-transmit signal at selected receiver stations and coupling said instruct-to-transmit signal to the computers associated with said selected stations, and

causing said last named computers to generate and transmit their user specific signals to their associated output devices in response to said instruct-to-transmit signal, thereby to transmit to the selected output devices an output signal comprising said data and said related user specific signals, the output signals at a multiplicity of said output devices being different, with each output signal specific to a specific user.

controlling one or more of said selective transmission devices, and with said remote transmitter station adapted to detect the presence of one or more control signals, to control the communication of specific instruct signals in response to detected specific control signals, and to deliver at its broadcast or cablecast transmitter one or more instruct signals, said one or more instruct signals being effective at a receiver station to generate a schedule and to output mass medium program materials in accordance with said schedule, said method of controlling [communicating] comprising the steps of:

(1) receiving said one or more instruct signals to be transmitted by the remote intermediate data transmitter station and delivering said one or more instruct signals to said [a] transmitter[, said one or more instruct signals being effective at a receiver station to generate a schedule and to output mass medium program materials in accordance with said schedule];

(2) receiving said one or more control signals which at the remote intermediate data transmitter station operate to control the communication of said one or more instruct signals; and

(3) transmitting said one or more control signals to said transmitter before a specific time.

iii. **Third representative claims, U.S. patent 4,965,825, claim 24 covering present application, claim 4**

Claim 24 of U.S. Patent No. 4,965,825 covers a method of generating user specific output information at a multiplicity of receiver stations. Each receiver station is programmed with a special user application and has a computer adapted to generate user specific output information. Each receiver station has an output device to which its computer transmits a user specific signal. At a time when the user specific output

information does not exist, an instruct-to-generate signal is transmitted to the receiver stations. In response to the instruct-to-generate signal, the computers generate and transmit to the output devices the user specific output information in user specific signals which are different, "with each output signal specific to a specific user". Present application claim 4 relates to a method of controlling a remote intermediate data transmitter station to communicate data to one or more receiver stations. One or more instruct signals are received and delivered to a transmitter, the instruct signals being effective at a receiver station to generate a schedule and to output mass medium program materials in accordance with the schedule. One or more control signals are received, which at the remote intermediate data transmitter station operate to control the communication of the instruct signals. The control signal(s) are transmitted before a specific time.

Patent claim 24 relates to transmission of user specific information at a time when said information does not exist. Also, in patent claim 24, each receiver station is programmed with a special user application. These limitations and features are not directly addressed or inferred by present application claim 4. There is no limitation in present application claim 4 that the unit of programming be delivered at a time when the programming or the receiver specific signal does not exist. Present application claim 4 does not address or imply the concept of the receiver station being programmed with a special user application. Patent claim 24 does not directly address or infer the concept of controlling a remote intermediate data transmitter station to communicate data to one or more receiver stations. Patent claim 24 does not cover present application claim 4. The two claims are capable of separate manufacture, use, and sale as claimed. These two inventions are distinct.

U.S. patent 4,965,825, claim 24

In a method of generating computer

Present application, claim 4 (amended)

A method of controlling a remote

output at a multiplicity of receiver stations each of which includes a computer adapted to generate and transmit user specific output information content and user specific signals to one or more associated output devices, with at least one or more associated output devices, with at least some of said computers being programmed to process modification control signals so as to modify said computers' method of processing data and generating output information content, each of said computers, being programmed to accommodate a special user application, the steps of:

transmitting an instruct-to-generate signal to said computers at a time when corresponding user specific output information content does not exist, and causing said last named computers to generate their user specific output information content in response to said instruct-to-generate signal, thereby to transmit to each of their associated output devices an output information content and the user specific signal of its associated computer, the output signals at a multiplicity of said output devices being different, with each output signal specific to a specific user.

intermediate data transmitter station to communicate data to one or more receiver stations, with said remote transmitter station including a broadcast or cablecast transmitter for transmitting one or more signals which are effective at a receiver station to instruct a computer or processor, a plurality of selective transmission devices each operatively connected to said broadcast or cablecast transmitter for communicating a unit of data, a data receiver, a control signal detector, and a controller or computer capable of controlling one or more of said selective transmission devices, and with said remote transmitter station adapted to detect the presence of one or more control signals, to control the communication of specific instruct signals in response to detected specific control signals, and to deliver at its broadcast or cablecast transmitter one or more instruct signals, said one or more instruct signals being effective at a receiver station to generate a schedule and to output mass medium program materials in accordance with said schedule, said method of controlling [communicating] comprising the steps of:

(1) receiving said one or more instruct signals to be transmitted by the remote intermediate data transmitter station and delivering said one or more instruct signals to said [a] transmitter[, said one or more instruct signals being effective at a receiver station to generate a schedule and to output mass medium program materials in accordance with said schedule];

(2) receiving said one or more control signals which at the remote intermediate data transmitter station operate to control the communication of said one or more instruct signals; and

(3) transmitting said one or more control signals to said transmitter

| before a specific time.

**iv. Fourth representative claims, U.S. patent 5,109,414,
claim 15 covering present application, claim 4**

Claim 15 of U.S. Patent No. 5,109,414 covers a signal processing system which receives data from a data source and outputs the data to a matrix switch and a detector, control signals are detected within the received data and stored for further processing, and a processor controls the directing functions of (1) the matrix switch which receives the data as input and can direct selected portions of the data to a data transmission means and (2) the device which stores and transfers the control signals to the processor. Present application claim 4 relates to a method of controlling a remote intermediate data transmitter station to communicate data to one or more receiver stations. One or more instruct signals are received and delivered to a transmitter, the instruct signals being effective at a receiver station to generate a schedule and to output mass medium program materials in accordance with the schedule. One or more control signals are received, which at the remote intermediate data transmitter station operate to control the communication of the instruct signals. The control signal(s) are transmitted before a specific time.

Patent claim 15 relates to controlling a matrix switch to communicating data from a single data source to a data transmission selectively by processing control signals which are detected within the data and stored for further processing. Application claim 4 does not directly address or infer the concepts of a matrix switch, a detector, or storage of control signals. Patent claim 15 does not directly address or infer the concept of controlling a remote intermediate data transmitter station to communicate data to one or more receiver stations. Patent claim 15 does not cover present application claim 4. The two claims are capable of separate manufacture, use, and sale as claimed. These two inventions are distinct.

U.S. patent 5,109,414, claim 15

In a signal processing system,
a receiver/distribution means for receiving data from a data source and for outputting said data to a matrix switch means and a control signal detector means,
a matrix switch means for receiving said data from said receiver/distributor means and for directing selected portions of said received data to a data transmission means,
a control signal detector means for detecting control signals respecting said data and transferring said control signals to a storage/transfer means, said control signal means being configured to detect said control signals at a predetermined location within said data,
a storage/transfer means for receiving and storing said control signals and for transferring at least a portion of said control signals to a processor means for further processing, and
a processor means for controlling the directing functions of said matrix switch means and the transfer functions of said storage/transfer means based on instructions contained in said control signals.

Present application, claim 4 (amended)

A method of controlling a remote intermediate data transmitter station to communicate data to one or more receiver stations, with said remote transmitter station including a broadcast or cablecast transmitter for transmitting one or more signals which are effective at a receiver station to instruct a computer or processor, a plurality of selective transmission devices each operatively connected to said broadcast or cablecast transmitter for communicating a unit of data, a data receiver, a control signal detector, and a controller or computer capable of controlling one or more of said selective transmission devices, and with said remote transmitter station adapted to detect the presence of one or more control signals, to control the communication of specific instruct signals in response to detected specific control signals, and to deliver at its broadcast or cablecast transmitter one or more instruct signals, said one or more instruct signals being effective at a receiver station to generate a schedule and to output mass medium program materials in accordance with said schedule, said method of controlling [communicating] comprising the steps of:

- (1) receiving said one or more instruct signals to be transmitted by the remote intermediate data transmitter station and delivering said one or more instruct signals to said [a] transmitter[, said one or more instruct signals being effective at a receiver station to generate a schedule and to output mass medium program materials in accordance with said schedule];
- (2) receiving said one or more control signals which at the remote intermediate data transmitter station

operate to control the communication of
said one or more instruct signals; and
(3) transmitting said one or
more control signals to said transmitter
before a specific time.

J. Rejection of Claims 3-7 Under 35 U.S.C. §101

In paragraph 25 of the Office Action, the examiner rejected claims 3-7 under 35 USC §101 as claiming the same invention as claims 3-7 of prior U.S. Patent Application Serial No. 08/449,652. The examiner failed to more specifically explain this ground of rejection. Nonetheless, applicants will address the rejection.

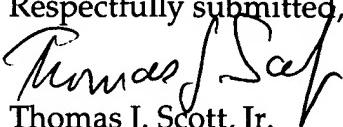
Applicants first point out that in accordance with MPEP §804 (Chart I-A; ¶8.32), the examiner should have made a "Provisional Statutory Double-Patenting Rejection." This is because the claims of U.S. Patent Application Serial No. 08/449,652 have not yet been patented.

Applicants next traverse the examiner's rejection, and submit that the scope of claims 3-7, as amended, in this application is different from the scope of claims 3-7 in Appl. S/N 08/449,652 (i.e., an embodiment of the invention exists which falls within the scope of claims 3-7 of the pending application but does not fall within the scope of claims 3-7 of Appl. S/N 08/449,652). Applicants respectfully request that this rejection be withdrawn.

III. CONCLUSION

All of the examiner's outstanding grounds of objection and rejection have been properly accommodated, traversed or rendered moot. Applicants therefore respectfully request that the examiner allow claims 2-7. The examiner is invited to call the undersigned at the telephone number indicated below if such a call would facilitate the prosecution of this application.

Date: November 13, 1996
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Respectfully submitted,

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